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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,605	07/14/2000	Scott A. Kliger	2182.1011-001	6154

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EXAMINER

GEREZGIHER, YEMANE M

ART UNIT PAPER NUMBER

2144

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/616,605

Applicant(s)

KLIGER ET AL.

Examiner

Yemane M. Gerezgiher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5, 12-14 and 21 is/are allowed.
- 6) ☐ Claim(s) 1, 2, 6-11 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Amendment received on 02/24/2005 has been entered. Claims 1-21 remain pending.

***Allowable Subject Matter***

2. Claims 3-5, 12-14 and 21 are allowed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 6-11, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (U.S. Patent Number 5,933,811) in view of Landsman et al. (U.S. Patent Number 6,785,659).

As per claim 1: (a) downloading a Web page file from a Web server, the Web page file including at least one advertising fragment; [Column 2, Lines 62 through Column 3, Line 5 and on Fig. 3 Steps 302 and 304, Angles disclosed requesting for a for electronic page and downloading the requested page along with embedded advertisement request. Angles further recited, "After obtaining the advertisement request, the content provider embeds the advertisement

request into its electronic documents. When a registered consumer accesses a content provider's website, the content provider website transfers the electronic document and the embedded advertisement request to the consumer's computer. The embedded advertisement request directs the consumer computer to invoke the referenced content provider script in the advertisement provider computer." See Column 3, Lines 40-49].

(b) locating an advertising applet program on an applet server using the advertising fragment, [Similarly, as disclosed above, Angles disclosed "...the embedded advertisement request directing the client machine to invoke the referenced content provider script (a third party server as an "applet server" as recited in the claim) in the advertisement provider computer. See Column 3, Lines 40-49] the advertising applet program containing program logic specifying how to construct the customizable advertisement; [For clarification purpose, by definition an applet is generally known as: 1). A small Java program that can be downloaded quickly and used by any computer equipped with a Java-capable browser, which adds animation and interactivity to the Web page or 2). A program, intended for delivery over the Internet, which can be included in an HTML page, just as an image can be included or 3). An applet is a program (generally written in the Java programming language) that is part of content, and that the user agent executes or 4). A client-side program written in Java or JavaScript that downloads and executes on the end user's computer rather than executing on the server].

(c) running the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement. [As it is clearly pointed out above, by definition an applet is a client side language that is executed only at the client browser].

**Despite the fact that an applet is/was very well known and universally used scheme in a global communication network and specifically in a web based applications or despite the definition of an applet described above, the teachings of Angles was silent about requesting such a program (applet program) from an applet server and running the applet program at a client machine to construct the image representation of the personalized advertisement content.** Instead, Angles taught constructing the customized advertisement at a server side and sending the constructed advertisement to a client machine where it got integrated with the web page and presented to the targeted consumer. See Fig.3 and 4.

However, as evidenced by the teachings of Landsman it was well known in the art at the time of the invention, to request such a script/applet program (See Abstract ("totally "decouples" advertising content from a web page such that a web page, rather than embedding actual advertising content within the page itself, merely includes an advertising tag that refers, via a URL, to a specific ad management system rather than to a particular advertisement or its content."), Column 17, Line 37 through Column 18, Line 47, Landsman

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disclosed loading and executing the script/applet at the client browser. Further Landsman disclosed when applet is executed by the client machine/browser generating, playing/displaying the selected advertisement at the client browser. See column 18 Lines 42-65 and see Figures. 1B, 1E, 2A, 2B, 10 and Column 9, Line 53 through Column 10, Line 22.

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Landsman related to executing an applet at a client side to construct a customized advertisement banner and have modified the teachings of Angles related to delivering customized electronic advertisements constructed at a server system and delivering the constructed customized advertisement to the client system, because "such a technique would likely provide considerable economies to advertisers in saved labor, time and cost in terms of both inserting advertisements into web page files, and later changing any of those advertisements." See Landsman Column 9, Lines 15-19. Furthermore, in order to "minimize ad insertion cost, effort and time while restricting disclosure of the agent server and advertisement source information. See column 18 Lines 63-65.

As per claims 10 and 19, these claims have substantially similar limitations as claim 1 rejected above. Therefore, these claims are rejected with the same rationale. Furthermore, Since the already combined teachings of Landsman and Angles are used through the means of a computer system, an

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apparatus and a computer program comprising a computer usable medium comprising a set of computer program instructions embedded on the computer usable medium to perform the functional limitations as recited in claims 10 and 19 were inherently disclosed by Angles.

As per claims 2, 11, and 20: Angles disclosed the claimed limitation ("determining user profile parameters for constricting customizable advertisements; and using the user profile parameters as input to the advertisement program when constructing the customizable advertisement" See Column 3, Lines 6-17 "The advertisement provider's computer stores demographic information about consumers, and sends customized advertisements to the consumers based on the consumers demographic profile and tracks consumer responses to the customized advertisements. For example, when accessing a content provider's website, a consumer with a demographic profile indicating an interest in farming would be sent customized advertisements for farm products by the advertisement provider. Customer requests for more information about the advertised farm products are also monitored."), and Column 3, Lines 56-64 ("The advertisement provider uses the consumer member code to identify the consumer's demographic profile and preferences. The advertisement provider then selects an appropriate advertisement based on the consumer's profile and sends the customized advertisement to the consumer computer. The consumer computer then merges the content provider's electronic document with the advertisement

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provided by the advertisement provider to create a single displayed document to the consumer.”). Angles taught the advertisement request embedded with in the document been *populated* with advertisement content by the advertising server. See Column 8, Lines 58-61.

Angels recited, “Referring to FIG. 3, an overview of the process of a consumer requesting an electronic document is shown. At start state 300 the process initializes and moves to state 302 wherein the consumer computer 12 requests an electronic page 32 from the content provider computer 14. As discussed in more detail below, the consumer computer 12 uses Internet browsing software (not shown) to access the content provider's URL address. The consumer browser software then accesses an electronic document 32 stored on the content provider computer 14. Moving to state 304, the content provider computer 14 sends the electronic document 32 and the embedded advertisement request to the consumer computer 12. Proceeding to state 306, the consumer computer executes the advertisement request 26 and establishes a communications link with the advertisement provider computer 18. Proceeding to state 308, the advertisement request 26 directs the advertisement provider computer 18 to execute a content provider script, which contains the content provider member code. In addition, during state 308, the advertisement



provider computer 18 obtains the consumer member code 22 stored on the consumer computer 12". See Column 8, Lines 33-54 and Fig. 3.

As per claims 6 and 15: wherein the advertising fragment contains populated advertising content. See Column 8 Lines 58-61.

As per claims 7 and 16: wherein the advertising fragment is stored on an advertising server, separate from the Web server [see Fig. 4 Reference 14 showing a content provider computer and reference 18 an advertisement provider computer separate from the content provider] and the advertising server and the Web server are in communication to provide the advertising fragment. [See Figs. 1, advertisement provider computer and the content provider computer providing the customized advertisement content to the client].

As per claims 8, 9, 17 and 18: requesting advertising content from the applet server or requesting advertising content from a content server in communication with the applet server. [See Fig. 3, client machine requesting customized advertisement from an advertisement provider].

### ***Response to Arguments***

5. Applicant's arguments filed 02/24/2005 have been fully considered but they are not persuasive.

a. The inventive entity/entities recite, "Applicants respectfully note that the claim language referenced by the Office Action appears to be a paraphrased interpretation of the language of several claims. Applicants do not endorse this paraphrased language and addressed the rejection as it pertained to the exact language of the claims in the response..." see applicants Remark on Page 10 last ¶.

The examiner respectfully disagrees with such allegation. As any standard examination process, the language of the claimed limitations are included and mapped to the teachings of the prior art. In this case some of the claimed limitations of the claims are incorporated into the office action for clarity of the mapping of the core limitations of the claimed invention and mapped or pointed to the teachings of the prior art accordingly. However, the examiner suspects that the applicants concern may have been due to the very same nature of the language found in the teachings of the prior art.

b. The inventive entity/entities further incorporate the details of the office action and the claimed language in to the remarks to merely negate the applied teachings of Angles and Landsman in the office action without any specific details why the combined teachings of Landsman and Angles failed to teach the invention as claimed. See applicants remark on pages 11-14. Furthermore, the applicant appears to argue that none of the limitations (highlighted or underlined on the remarks pages 12 & 13

**also disclosed below)** are taught by the combined teachings of Landsman and Angles.

Regarding claims 1 and 19, Landsman does not teach, within the context of the claimed invention, the Applicants invention, including:

- (a) downloading a Web page file from a Web server, the Web page file including at least one advertising fragment;
- (b) locating an advertising applet program on an applet server using the advertising fragment, the advertising applet program containing program logic specifying how to construct the customizable advertisement;
- (c) running the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement.

(Emphasis added). Further, Landsman does not teach the invention of claim 10 which is directed to:

An apparatus for dynamically providing a Web page with a user specific advertisement banner on a client computer display comprising:

a Web browser requesting a Web page stored on a Web server containing an advertising fragment;  
a reference to an advertising applet program on an applet server obtained using the advertising fragment; and  
the advertising applet program constructing the advertisement banner on the client computer for display in the Web browser.

The examiner respectfully disagrees with that contention. First of all, the highlighted limitation above is substantially the very basic definition of an applet program (see claim rejection applied to claim 1). Further, the examiner asserts that the teaching of Landsman indeed disclosed executing an applet program at a client machine and constricted the customizable advertisement. See Abstract, column 18 Lines 42-65 and see Figures. 1B, 1E, 2A, 2B, 10 and Column 9, Line 53 through Column 10, Line 22.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane M. Gerezgiher whose

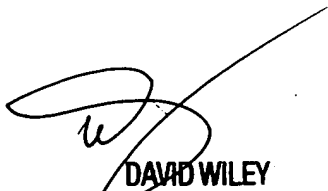
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telephone number is (571) 272-3927. The examiner can normally be reached on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached at (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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